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09/882,178	06/18/2001	Hiroshi Ikeda	1614.1171	8007

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EXAMINER
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PHAM, HUNG Q

ART UNIT	PAPER NUMBER
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2168

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/882,178	<b>Applicant(s)</b> IKEDA ET AL.	
	<b>Examiner</b> HUNG Q. PHAM	<b>Art Unit</b> 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15-18 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-12 and 19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Election/Restrictions***

Applicant's election without traverse of claims 1-12 and 19 in the reply filed on 05/30/06 is acknowledged.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: *an updating part*, *a sending part* as in claim 7, *an action information sending part* as in claim 8, *a defining part*, *a registering part*, *a member information obtaining part* as in claim 9, and *an excluding part* as in claim 19.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-8 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

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Claims 1-6, especially claim 1, recites *a web site system*. Instead of identifying the physical structure of the system in term of its hard ware or hard ware and software combination as set forth in MPEP 2106 (IV)(B)(2)(a)<sup>1</sup>, the *web site system* of claim 1 comprising *a member information database*. A database is a file composed of records. A database is not hard ware or hard ware and software combination that are required to define the system. Therefore, claims 1-6 are non-statutory.

Claims 7 and 8 recite *a center site* and *a service site*. Instead of identifying the physical structure of the system in term of its hard ware or hard ware and software combination as set forth in MPEP 2106 (IV)(B)(2)(a), the *center site* and *service site* as claimed comprise only functional software. Therefore, claims 7 and 8 are non-statutory.

Claim 19 recites *a web site system*. Instead of identifying the physical structure of the system in term of its hard ware or hard ware and software combination as set forth in MPEP 2106 (IV)(B)(2)(a), the *web site system* as claimed comprises only functional software. Additionally, the web site system as claimed does not produce a useful, concrete and tangible result as set forth in MPEP 2106 (IV)(B)(2)(b)(ii)<sup>2</sup>.

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<sup>1</sup> MPEP 2106 (IV)(B)(2)(a):

Products may be either machines, manufactures, or compositions of matter. A machine is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

...

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760.

Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

<sup>2</sup> MPEP 2106 (IV)(B)(2)(b)(ii):

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12 and 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As in claim 12, the step of *searching shops based on the service region and the search range, so that information related to one shop located in the search range is not retrieved in said searching when the registered service region of the one shop is out of a search range* is not described in the specification.

As in claim 19, the claimed limitation *member information database comprising: a defining part defining a plurality of places as a single region; a registering part registering said single region to said member information database; and an excluding part specifying places to be excluded and excluding said places from said single region registered by said registering part.*

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For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1536-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("impatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601) and/or when a specific machine is being claimed (as in *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (\**arc-banc*)). For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4, 11, 12 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Naidoo [USP 6,629,136 B1].**

Regarding claim 1, Naidoo teaches *a web site system including a center site and a plurality of service sites accessible through said center site* (Web Server 120 is *a center site* (FIG. 1). Telephone directories, medical services, chat room services, email services and other websites that are linked to the Web Server as *service sites accessible through center site* (Col. 5, Lines 44-55)), said web site system comprising:

*a member information database managed in said center site and storing member information* (User Registration Database 126 as *member information database* is managed by Web Server 120 (Col. 7, Lines 43-45). User Registration Database stores *member information* (Col. 8, Lines 60-63)), wherein:

*said member information database stores the member information obtained through said center site or said plurality of the service sites* (Col. 8, Lines 25-27), *in which the member information includes a home address and a proximal station when the member information is registered to said information database* (registration information includes user *home address* and other geographic location, e.g., city as *proximal station* (Col. 8, Lines 27-35, Col. 9, Lines 19-25))

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*so as to retrieve information available in both a predetermined range of the home address and a predetermined range of the proximal station*<sup>3</sup> (The purpose is to retrieve information from a predetermined range of the home address (Col. 10, Lines 48-52), and a predetermined range of the proximal station (Col. 10, Lines 57-58)).

Regarding claim 11, Naidoo teaches *a method to search information, said method conducted by one of service sites in a web site system including a center site and said service sites accessible through said center site* (Web Server 120 is *a center site*. User Node 100 is *one of service sites* (FIG. 1). Telephone directories, medical services, chat room services, email services and other websites that are linked to the Web Server as *service sites accessible through center site* (Col. 5, Lines 44-55)), said method comprising:

*storing member information in which the member information includes a home address and a proximal station when the member information is registered* (registration information includes user *home address* and other geographic location, e.g., city as *proximal station* (Col. 8, Lines 27-35, Col. 9, Lines 19-25))

*so as to retrieve information available in both a predetermined range of the home address and a predetermined range of the proximal station* (The purpose is to retrieve information from a predetermined range of the home address (Col. 10, Lines 48-52), and a predetermined range of the proximal station (Col. 10, Lines 57-58)); and

*providing information suitable for a service type by changing a search region for each service type* (Col. 12, Lines 14-55).

<sup>3</sup> As set forth in MPEP 2111.04:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*

The clause *so as to retrieve information available in both a predetermined range of the home address and a predetermined range of the proximal station* simply expresses the intended result of the step storing member information. Examiner respectfully suggests applicants replacing the "so as to" clause by a positive statement that discloses the claimed invention.

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Regarding claim 12, Naidoo teaches method to search information, said method conducted by one of service sites in a web site system including a center site and said service sites accessible through said center site, said method comprising:

*registering a service region for each shop providing a service to a user* (Col. 10, Lines 5-27);

*registering a home address and a proximal station* (registration information includes user home address and other geographic location, e.g., city as proximal station (Col. 8, Lines 27-35, Col. 9, Lines 19-25))

*so as to retrieve information available in both a predetermined range of the home address and a predetermined range of the proximal station which are defined as a search range* (The purpose is to retrieve information from a predetermined range of the home address (Col. 10, Lines 48-52), and a predetermined range of the proximal station (Col. 10, Lines 57-58)); and

*searching shops based on the service region and the search range, so that information related to one shop located in the search range is not retrieved in said searching when the registered service region of the one shop is out of a search range* (Col. 10, Lines 53-63).

Regarding claim 19, Naidoo teaches *a web site system comprising a center site and service sites accessible through said center site, where the center site comprises a member information database* (Web Server 120 is a center site (FIG. 1). Telephone directories, medical services, chat room services, email services and other websites that are linked to the Web Server as *service sites accessible through center site* (Col. 5, Lines 44-55). User Registration Database 126 as *member information database* is managed by Web Server 120 (Col. 7, Lines 43-45)), said member information database comprising:

*a defining part defining a plurality of places as a single region* (Col. 8, Lines 32-41);

*a registering part registering said single region to said member information database* (Col. 8, Lines 25-27 and Col. 7, Lines 43-45); and

*an excluding part specifying places to be excluded and excluding said places from said single region registered by said registering part* (Col. 10, Lines 53-63).

Regarding claim 2, Naidoo teaches all of the claimed subject matter as discussed above with respect to claim 1, Naidoo further discloses *when the user accesses one service site of the plurality of service sites through said center site, said center site retrieves the member information corresponding to the user from said member information database and sends the member information including a search range, to said one service site* (Col. 10, Lines 53-63).

Regarding claim 3, Naidoo teaches all of the claimed subject matter as discussed above with respect to claim 2, Naidoo further discloses *center site retrieves the member information of the user from said member information database, classifies the member information, and sends a class of the member information as a part of or as the entire member information* (Col. 9, Line 9-Col. 10, Line 27).

Regarding claim 4, Naidoo teaches all of the claimed subject matter as discussed above with respect to claim 1, Naidoo further discloses *center site sends member ID information to one of the plurality of service sites corresponding to the user, where said one of the service sites retrieves the member information including the search range of the user from said center site by using said member ID information* (Col. 8, Lines 60-63 and Col. 12, Lines 5-55).

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**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick [USP 5,717,923] in view of Naidoo [USP 6,629,136 B1].**

Regarding claim 7, Dedrick teaches a system for dynamically customizing electronic information. The system as taught by Dedrick has *a center site including a member information database storing member information* (Dedrick, FIG. 3, METERING SERVER as *center site including a member information database*, e.g., USER PROFILE DATABASE, *storing member information*, e.g., profile data). The METERING SERVER comprising:

*an updating part updating said member information in response to each action performed by a user at service sites* (Dedrick, Col. 6, Lines 53-63);

*a sending part sending the member information, when the user accesses one of the service sites or when any one of said service sites inquires as to the member information (Dedrick, Col. 7, Lines 35-56);*

*wherein each member information from said service sites connected to said center site is stored in said member information database (Dedrick, Col. 9, Lines 25-34) and said member information database is a single database for said service sites (Dedrick, Col. 9, Lines 25-34, USER PROFILE DATABASE is a single database for consumption devices as service sites served by METERING SERVER), in which said each member information includes a home address and a proximal station (Dedrick, Col. 5, Lines 50-59, mailing address include a home address and the zip code as proximal station).*

The missing of Dedrick is the intended use limitation of the mailing address in order *to retrieve information available in both a predetermined range of the home address and a predetermined range of the proximal station which are defined as a search range.*

Naidoo teaches a technique of searching localized content to users corresponding to users' geographic area. Naidoo further discloses the step of *retrieve information available in both a predetermined range of the home address and a predetermined range of the proximal station which are defined as a search range* (Naidoo, Col. 10, Lines 48-52 and Col. 10, Lines 57-58).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to include the searching technique as taught by Naidoo into Dedrick system in order to search for a particular area using the mailing address.

Regarding claim 8, Dedrick teaches a system for dynamically customizing electronic information. The system as taught by Dedrick has *a service site accessible through a center site* (Dedrick, FIG. 1, CLIENT SYSTEM as *a service site accessible through a METERING SERVER as center site*) *including a member information database storing member information* (Dedrick, FIG. 3, METERING SERVER *including a member information database, e.g., USER PROFILE DATABASE, storing member information, e.g., profile data*). The CLIENT SYTSEM further comprising:

*an action information sending part sending information concerning an action of a user to update said member information database when the user performs the action at said service site, the action is made for the information retrieved* (Dedrick, Col. 7, Lines 23-25 and Col. 7, Lines 35-56),

*wherein said member information of said member information database in said center site is updated by and shared with other service sites accessible through said center site* (USER PROFILE DATABASE is updated by and shared with other CLIENT SYSTEMS),

*and said member information includes a home address and a proximal station* (Dedrick, Col. 5, Lines 50-59, mailing address include a *home address* and the zip code as *proximal station*);

The missing of Dedrick is the intended use limitation of the mailing address in order *to retrieve information available in both a predetermined range of the home address and a predetermined range of the proximal station which are defined as a search range*, and the information is retrieved *based on the search range*.

Naidoo teaches a technique of searching localized content to users corresponding to users' geographic area. Naidoo further discloses the step of *retrieve information available in both a predetermined range of the home address and a predetermined range of the proximal station which are defined as a search range* and the information is retrieved *based on the search range* (Naidoo, Col. 10, Lines 48-52 and Col. 10, Lines 57-58).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to include the searching technique as taught by Naidoo into Dedrick system in order to search for a particular area using the mailing address.

Regarding claim 9, Dedrick and Naidoo, in combination, teach all of the claimed subject matter as discussed above with respect to claim 8, Naidoo further discloses the technique of *obtaining the member information including the search range of the user from said center site when the user accesses said service site through said center site* (Naidoo, Col. 10, Lines 53-63).

Regarding claim 10, Dedrick and Naidoo, in combination, teach all of the claimed subject matter as discussed above with respect to claim 8, Naidoo further discloses the technique of *providing information specifying the user as a member to said center site so as to obtain the member information including the search range of the user from said center site* (Naidoo, Col. 8, Lines 51-59).

**Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naidoo [USP 6,629,136 B1] in view of Dedrick [USP 5,717,923].**

Regarding claim 5, Naidoo teaches all of the claimed subject matter as discussed above with respect to claim 1, but fails to teach *when the user performs an action at one of said plurality of service sites, said one of the service sites sends information corresponding to said action performed by the user to said center site*.

Dedrick teaches a system for dynamically customizing electronic information.

Dedrick further discloses *when the user performs an action at one of said plurality of service sites, said one of the service sites sends information corresponding to said action performed by the user to said center site* (Col. 9, Lines 35-65).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to include the step of sending information corresponding to action in order to update the user profile.

Regarding claim 6, Naidoo and Dedrick, in combination, teach all of the claimed subject matter as discussed above with respect to claim 5, Dedrick further discloses *center site updates the member information of the user in said member information database by using said information corresponding to said action performed by the user* (Dedrick, Col. 9, Lines 32-34).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
HUNG Q PHAM  
Examiner  
Art Unit 2168

August 14, 2006